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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,132	10/20/2000	Adnanus Henricus Nicolaas Roestenburg	583-1040	7838

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EXAMINER
DUONG, THOMAS

ART UNIT	PAPER NUMBER
2145	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/693,132	ROESTENBURG ET AL.
		Examiner	Art Unit
		Thomas Duong	2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *17 July 2006*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-23, 27-33, and 55-85* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-23, 27-33, and 55-85* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action is in response to the applicants Amended Appeal Brief filed on July 17, 2006. *Claims 1-23, 27-33, and 55-85* are presented for further consideration and examination.

2.   Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

3.   In view of the appeal brief filed on February 8, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

Response to Argument

4.   Applicant's argument, see pg.10 – pg.21, filed on July 17, 2006, with respect to *claims 1-23, 27-33, and 55-85* have been fully considered and are persuasive. The finality of previous rejection is withdrawn.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   *Claim 1* is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

7.   With regards to *claim 1*, Applicants recite the limitation,

- *"personal data manipulation server"*

There is insufficient antecedent basis for this limitation in the claim.

8.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

9.   *Claim 65* is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement. The claims contains subject matter, which is not described in

such a way as to enable one skilled in the art to which it pertains, or with which it is most

nearly connected, to make and/or use the invention. The specification does not show

how the *"computer executable software code stored on a computer readable medium"*

"embodied in a computer data signal, the signal being transmitted over a tangible

medium or a wireless medium, for example microwave or infrared" can perform the

modules claimed. Please clarify the language of the claim.

10.   *Claim 67* is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement. The claims contains subject matter, which is not described in

such a way as to enable one skilled in the art to which it pertains, or with which it is most

nearly connected, to make and/or use the invention. The specification does not show

how the *"a computer readable medium having computer executable code stored*

thereon" "embodied in a computer data signal, the signal being transmitted over a

tangible medium or a wireless medium, for example microwave or infrared" can perform

the modules claimed. Please clarify the language of the claim.

Claim Rejections - 35 USC § 101

11.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or
composition of matter, or any new and useful improvement thereof, may obtain a patent
therefor, subject to the conditions and requirements of this title.

12.   *Claims 65 and 67* are rejected under *35 USC § 101* because the claims are not limited to

tangible embodiments since they do not claim physical articles or objects as part of the

claims to establish a statutory category as a machine or manufacture, and they are

clearly not to a process or composition of matter. As claimed, a *"computer executable*

software code stored on a computer readable medium" and *"a computer readable*

medium having computer executable code stored thereon" "embodied in a computer

data signal, the signal being transmitted over a tangible medium or a wireless medium,

for example microwave or infrared" fail to fall within a statutory category of invention. As

such, the above claims are not limited to statutory subject matter and are, therefore,

non-statutory. Hence, in order to overcome this *35 USC § 101* rejection, the above

claims need to be amended to include only the physical computer media and not a

transmission media or other intangible or non-functional media.

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

14.   *Claims 1-23, 27-33, and 55-85* are rejected under 35 U.S.C. 103(a) as being

unpatentable over Tso et al. (US006421733B1) and in view of Zhao et al.

(US006944677B1).

15.   With regard to *claims 1, 12, 23, 55, 65-67, and 83-85*, Tso discloses,

- *a client equipment unit capable of communicating with a content providing server*

   for providing web content; (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16;

   fig. 3)

   Tso discloses, *"network client 12, via browser 32, transmits an HTTP request for*

   the hypertext object to transcoding server 34 over client/server communications

   link 14. Where browser 32 normally accesses Internet 18 through a proxy,

   browser 32 is configured to pass user requests through transcoding server 34

   (i.e., Applicants' data manipulation server) via browser's 32 standard proxy

   configuration procedures" (Tso, col.9, lines 54-60). In addition, Tso discloses,

   "for purposes of illustration, assume no entry exists in server-side cache memory

   30 for the requested hypertext object. HTTP remote proxy 36 then invokes a call

   to retrieve the hypertext object from Internet 18 over server/network

   communications link 16. Assuming the requested hypertext object is found,

   HTTP remote proxy 36 begins receiving an HTTP data stream representing the

hypertext object" (Tso, col.10, lines 27-34). Hence, Tso teaches of the client using a browser to access the Internet, via the transcoding server, in order to obtain content from the content provider.

- *a data manipulation server disposed in-line between the client equipment unit and the content providing server, the data manipulation server being remote from the client equipment unit, the data manipulation server being coupled to a data store arranged to store personal data relating to a user of the client equipment unit; wherein* (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3) Tso discloses, *"network client 12, via browser 32, transmits an HTTP request for the hypertext object to transcoding server 34 over client/server communications link 14. Where browser 32 normally accesses Internet 18 through a proxy, browser 32 is configured to pass user requests through transcoding server 34 via browser's 32 standard proxy configuration procedures"* (Tso, col.9, lines 54-60). In addition, Tso discloses, *"embodiments of the present invention provide the ability to dynamically transcode information transmitted between, for example, a network server computer and a network client computer. As used herein, the term 'transcode' applies to virtually any manipulation of data including, but not limited to, adding, modifying or deleting data"* (Tso, col.2, lines 44-49). Tso discloses, *"according to one embodiment, an apparatus for use in transmitting data between a network server and a network client over a communications link includes a parser coupled to a transcode server provider"* (Tso, col.2, lines 13-16). In addition, Tso discloses, *"in one particular implementation, illustrated in FIG. 3, transcoder 20 is installed in a remote transcoding server 34 arranged between network client 12 and Internet 18"* (Tso, col.3, lines 21-23) where the

content servers are located. Furthermore, according to Tso, *"in view of the*

foregoing description, it should be apparent that it is possible for there to be more

than one so-called 'smart' proxy arranged between a client device and a content

server device" (Tso, col.5, line 66 – col.16, line 2). Hence, Tso teaches of the

transcoding server (i.e., Applicants' data manipulation server) explicitly separated

from the client and resides between the client and the content server, which may,

in turn, be located somewhere on the Internet.

- *the data manipulation server is adapted to modify data communicated between*

   the client equipment unit and the content providing server in dependence on the

   data relating to the user in response to the personal data manipulation server

   intercepting a request message for obtaining the content, the request message

   being transmitted from the client equipment unit and addressed to the content

   providing server. (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3)

   Tso discloses, *"network client 12, via browser 32, transmits an HTTP request for*

   the hypertext object to transcoding server 34 over client/server communications

   link 14. Where browser 32 normally accesses Internet 18 through a proxy,

   browser 32 is configured to pass user requests through transcoding server 34 via

   browser's 32 standard proxy configuration procedures" (Tso, col.9, lines 54-60).

   In addition, Tso discloses, *"embodiments of the present invention provide the*

   ability to dynamically transcode information transmitted between, for example, a

   network server computer and a network client computer. As used herein, the

   term 'transcode' applies to virtually any manipulation of data including, but not

   limited to, adding, modifying or deleting data" (Tso, col.2, lines 44-49). Hence,

   Tso teaches of the transcoding server (i.e., Applicants' data manipulation server)

capable of virtually performing *"any manipulation of date including, but not limited to, adding, modifying or deleting data"* (Tso, col.2, lines 48-49). Furthermore, Tso discloses, *"as noted above, parser 22 may selectively invoke one of transcode service providers 24 based upon satisfaction of a predetermined selection criterion"* (Tso, col.6, lines 64-66), which may comprise *"user preferences, including preferred content quality/speed tradeoff, language, content rating, exclusion list, inclusion list, data type-specific preferences (for example, 'never download' images), include/exclude advertising, amount of advertising desired, offensive language removal, whether the user's defined or learned preferences may be disclosed (an to whom), custom rules or programs for filtering/transcoding/processing data, and shared preferences with either another user or a group of users (any of the forgoing user preferences may be explicitly defined or system predicated, such as based on usage statistics compiled over time"* (Tso, col.7, lines 43-54). Hence, Tso teaches of transcoding (i.e., personalizing, customizing, modifying) data obtained from the Internet based on user's preference or profile.

However, Tso does not explicitly disclose,

- *a data manipulation server disposed in-line between the client equipment unit and the content providing server, the data manipulation server being remote from the client equipment unit, <u>the data manipulation server being coupled to a data store arranged to store personal data relating to a user of the client equipment unit; wherein</u>*

Zhao teaches,

- *a data manipulation server disposed in-line between the client equipment unit and the content providing server, the data manipulation server being remote from the client equipment unit, the data manipulation server being coupled to a data store arranged to store personal data relating to a user of the client equipment unit; wherein* (Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39) Zhao discloses, *"a method of the invention is provided for providing user profile data to a remote system including the steps of providing a data repository for storing information, storing user profile data in the data repository for one or more users, and upon receiving a request, providing user profile information corresponding to a user to the remote system"* (Zhao, col.1, lines 37-42) and that *"the present invention may be implemented in any suitable type of environment, including an Internet or intranet environment"* (Zhao, col.2, lines 44-46). In addition, Zhao discloses, *"this user profile information can be maintained by the user in one place. This user profile information may include any desired information such as name, contact information, preferences, user credentials, financial information, etc. The user profile information may also include information instructing the information provider who is authorized to receive user profile information"* (Zhao, col.2, lines 17-23). Hence, Zhao teaches of maintaining data repositories for storing user related information in user profiles to support user personalized services.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the Zhao reference with the Zhao reference to present *"provide a user profile data repository to store user information and support user personalized services"* (Zhao, col.1, lines 28-29).

16.   With regard to *claims 2, 4, 13, 15, 56, and 58*, Tso and Zhao disclose,

- *wherein the modified data is the request message which is modified thereby to*

  personalise the content to be obtained by the client equipment. (Tso, col.2, lines

  9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11

  – col.6, line 39)

  Tso discloses, *"embodiments of the present invention provide the ability to*

  dynamically transcode information transmitted between, for example, a network

  server computer and a network client computer. As used herein, the term

  'transcode' applies to virtually any manipulation of data including, but not limited

  to, adding, modifying or deleting data" (Tso, col.2, lines 44-49).

- *wherein the modified web data is data providing the content* (Tso, col.2, lines 9-

  18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 –

  col.6, line 39)

  Tso discloses, *"embodiments of the present invention provide the ability to*

  dynamically transcode information transmitted between, for example, a network

  server computer and a network client computer. As used herein, the term

  'transcode' applies to virtually any manipulation of data including, but not limited

  to, adding, modifying or deleting data" (Tso, col.2, lines 44-49).

17.   With regard to *claims 3, 5, 14, 16, 27, 57, and 59*, Tso and Zhao disclose,

- *wherein the request message is a Hyper Text Transfer Protocol (HTTP) request*

  message. (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao,

  col.1, lines 37-58; col.2, line 11 – col.6, line 39)

- *wherein the data providing the content is Hyper Text Mark-up Language (HTML) data.* (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39)

18.   With regard to *claims 6-8, 17-19, 28-30, and 60-62*, Tso and Zhao disclose,

- *wherein the data relating to the user is static data.* (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39)

  Zhao discloses, *"this user profile information can be maintained by the user in one place. This user profile information may include any desired information such as name, contact information, preferences, user credentials, financial information, etc. The user profile information may also include information instructing the information provider who is authorized to receive user profile information"* (Zhao, col.2, lines 17-23).

- *wherein the static data is obtained from the user.* (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39)

  Zhao discloses, *"for use registration, a user is allowed to enter and/or update a user profile stored by the information provider"* (Zhao, col.3, lines 58-60).

- *wherein the static data is obtained from a content provider associated with the content.* (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39)

  Tso discloses, *"likewise, a proxy provider (for example, and Internet Service Provider (ISP)), can collect and make available to content providers information*

such as user preferences and data access statistics, as well as content provider

specific statistics (for example, how many users from a given region or a given

profile accessed a particular Web site, and at what time, in the past month).

Such information may be used for applications such as targeted advertising"

(Tso, col.9, lines 33-41).

19.   With regard to *claims 9-10, 20-21, 31-32, and 63-64*, Tso and Zhao disclose,

- *wherein the data relating to the user is dynamic data.* (Tso, col.2, lines 9-18;

    col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 –

    col.6, line 39)

    Tso discloses, *"likewise, a proxy provider (for example, and Internet Service*

    Provider (ISP)), can collect and make available to content providers information

    such as user preferences and data access statistics, as well as content provider

    specific statistics (for example, how many users from a given region or a given

    profile accessed a particular Web site, and at what time, in the past month).

    Such information may be used for applications such as targeted advertising"

    (Tso, col.9, lines 33-41).

- *wherein the dynamic data is obtained from an access or service provider*

    associated with supporting communications between the client equipment unit

    and the content providing server. (Tso, col.2, lines 9-18; col.3, line 45 – col.12,

    line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39)

    Tso discloses, *"likewise, a proxy provider (for example, and Internet Service*

    Provider (ISP)), can collect and make available to content providers information

    such as user preferences and data access statistics, as well as content provider

specific statistics (for example, how many users from a given region or a given

profile accessed a particular Web site, and at what time, in the past month).

Such information may be used for applications such as targeted advertising"

(Tso, col.9, lines 33-41).

20.   With regard to <u>claims 11, 22, and 33</u>, Tso and Zhao disclose,

- *wherein the data manipulation server is a proxy server.* (Tso, col.2, lines 9-18;

  col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 –

  col.6, line 39)

  Tso discloses, *"transcoder 20 may be implemented, for example, as a software*

  module installed in a network proxy, in a client device, in a network server

  device, or in a content server device" (Tso, col.3, lines 18-21).

21.   With regard to <u>claims 68-71, 73-76, and 78-81</u>, Tso and Zhao disclose,

- *wherein the data manipulation server is arranged to modify the data*

  communicated between the client equipment and the content providing server in

  dependence on a selected subset of the data relating to a user stored in the data

  store. (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1,

  lines 37-58; col.2, line 11 – col.6, line 39)

  Tso discloses, *"according to one embodiment, an apparatus for use in*

  transmitting data between a network server and a network client over a

  communication link includes a parser coupled to a transcode service provider.

  The parser is configured to selectively invoke the transcode service provider in

  response to a predetermined selection criterion" (Tso, col.2, lines 13-18).

- *wherein the data manipulation server is arranged to request the user of the client equipment unit to select the subset in response to intercepting the request message.* (Challenger, col.4, lines 40-49; col.6, lines 6-20, lines 31-38; col.7, line 62 – col.8, line 22)

  Tso discloses, *"as noted above, parser 22 may selectively invoke one of transcode service providers 24 based upon satisfaction of a predetermined selection criterion"* (Tso, col.6, lines 64-66), which may comprise *"user preferences, including preferred content quality/speed tradeoff, language, content rating, exclusion list, inclusion list, data type-specific preferences (for example, 'never download' images), include/exclude advertising, amount of advertising desired, offensive language removal, whether the user's defined or learned preferences may be disclosed (an to whom), custom rules or programs for filtering/transcoding/processing data, and shared preferences with either another user or a group of users (any of the forgoing user preferences may be explicitly defined or system predicated, such as based on usage statistics compiled over time"* (Tso, col.7, lines 43-54).

- *wherein the data manipulation server is arranged to determine the subset in dependence on at least one rule of a user defined rule set, the at least one rule applying to the content providing server.* (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39)

  Tso discloses, *"according to one embodiment, an apparatus for use in transmitting data between a network server and a network client over a communication link includes a parser coupled to a transcode service provider.*

The parser is configured to selectively invoke the transcode service provider in response to a predetermined selection criterion" (Tso, col.2, lines 13-18).

- *wherein the data manipulation server is arranged to modify the data communicated between the client equipment and the content providing server in dependence on a selected subset of the data relating to a user stored in the data store.* (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39)

Tso discloses, *"according to one embodiment, an apparatus for use in transmitting data between a network server and a network client over a communication link includes a parser coupled to a transcode service provider. The parser is configured to selectively invoke the transcode service provider in response to a predetermined selection criterion"* (Tso, col.2, lines 13-18).

22. With regard to *claims 72, 77, and 82*, Tso and Zhao disclose,

- *wherein the data manipulation server is operated by an access or service provider associated with supporting communications between the client equipment unit and the content providing server.* (Tso, col.2, lines 9-18; col.3, line 45 – col.12, line 16; fig. 3; Zhao, col.1, lines 37-58; col.2, line 11 – col.6, line 39)

Tso discloses, *"the remote proxy may reside anywhere on a suitable network, such as the Internet, including at particular content provider sites. Alternatively, the remote proxy may be located at ISP local POPs (Point of Presence), for example, if location-specific characteristics are to be used as predetermined selection criteria"* (Tso, col.15, lines 33-38).
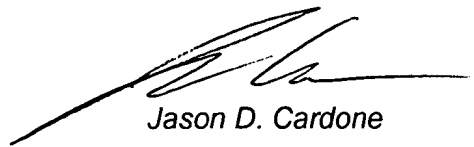
Conclusion

23.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Thomas Duong whose telephone number is 571/272-3911. The

examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the

examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone

can be reached on 571/272-3933. The fax phone numbers for the organization where

this application or proceeding is assigned are 571/273-8300 for regular communications

and 571/273-8300 for After Final communications.

Thomas Duong (AU2145)   *Jason D. Cardone*

October 14, 2006   *Supervisory PE (AU2145)*